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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,612

09/21/2006

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

03/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/593,612	Applicant(s) SUGIKI ET AL.	
	Examiner Cynthia Hamilton	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/21/09, 02/27/07, 02/09/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/09/2009, 02/27/2007, 09/21/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The examiner notes for the record that the Information Disclosure Statement filed 21 September 2006 had one sheet of references but the sheet was labeled as 1 of 2 sheets. There was no second sheet to be considered of record. The first sheet was so noted as the only sheet of record.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuroda et al (US 6,524,763 B1). With respect to instant claims 5-6, tris [4-diethylamino)phenyl]methane in line 39 of col. 4 of Kuroda is a compound anticipating the instant genus and species of pigments claimed as the compound is inherently a pigment. Mere recitation of newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can required applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product

Art Unit: 1795

and process claims reasonably considered as possessing allegedly inherent characteristics. In re Best, Bolton and Shaw (CCPA) 195 USPQ 430.

5. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Rauner et al (4,139,390). With respect to instant claims 5-6, tris (p-dibutylaminophenyl) methane, tris (p-di-t-butylaminophenyl) methane and tris (p-diethylaminophenyl) methane in lines 57-58,61 of col. 9 of Rauner et al are a compounds anticipating the instant genus and species of pigments claimed as the compound and are inherently pigments. Mere recitation of newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can required applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics. In re Best, Bolton and Shaw (CCPA) 195 USPQ 430.

6. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Gatzke et al (4,139,390). With respect to instant claims 5-6, tris (p-diethylaminophenyl) methane in lines 57-58,61 of col. 9 of Gatzke et al is a compound anticipating the instant genus and species of pigments claimed and is inherently a pigment. IN Gatzke et al see particularly column 14, lines 1-15. Mere recitation of newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can required applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be

Art Unit: 1795

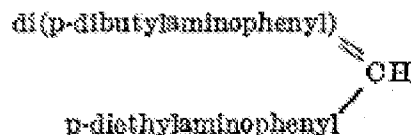
critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics. In re Best, Bolton and Shaw (CCPA) 195 USPQ 430.

7. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by McGuckin (CA 1039550). With respect to instant claims 5-6, the first two compounds in Table I on page 42 of McGuckin anticipate the instant genus and the second compound anticipates the species and genus. Both are inherently a pigments. They are tris (p-diethylaminophenyl) methane and tris (p-dipropylaminophenyl) methane. Mere recitation of newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can required applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics. In re Best, Bolton and Shaw (CCPA) 195 USPQ 430.

8. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Balon et al (US 2,755,202). With respect to instant claim 5, the product of Example 11, i.e. the unsymmetrical hexaalkyl-triamino triphenyl methane, of Balon et al shown as

Art Unit: 1795

The product, which is believed to be an unsymmetrical hexaalkyl-triamino-triphenyl methane of the structure:



or the tri (di n

butylaminophenyl) methane of Example 10, in the paragraph bridging column 9 and 10 of Balon et al anticipate the instant genus and are inherently pigments. With respect to instant claim 6, the leuco ethyl violet of line 35, col. 3 of Balon et al anticipates the instant pigment of claim 6. Mere recitation of newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can required applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics. In re Best, Bolton and Shaw (CCPA) 195 USPQ 430.

9. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerlach et al (US 3,658,543). With respect to instant claims 5-6, Gerlach et al discloses in lines 65-68 in column 3, tris(p-dibutylaminophenyl)methane, tris(p-di-n-butylaminophenyl)methane, and tris(p-diethylaminophenyl)methane. All of these compounds anticipate the pigments of the instant invention. Mere recitation of newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can required applicant to prove that subject matter shown to be in prior art does not

Art Unit: 1795

possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics. In re Best, Bolton and Shaw (CCPA) 195 USPQ 430. The examiner notes that Gerlach et al in column 14, lines 30-36, teaches the use of the compositions made with these compounds includes radiation dosimeters. No mention of epoxy or photo-radically curable resin are made by Gerlach et al.

10. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kurita et al (US 4,251,619). With respect to instant claims 5-6, Gerlach et al discloses in lines 51-54 in column 8, tris(p-dibutylaminophenyl)methane, tris(p-di-n-butylaminophenyl)methane, and tris(p-diethylaminophenyl)methane. All of these compounds anticipate the pigments of the instant invention. Mere recitation of newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can required applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics. In re Best, Bolton and Shaw (CCPA) 195 USPQ 430. Kurita et al teach the use of these compounds in compositions with free radically curable resins but no mention of epoxy resin is made.

11. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Dessauer et al (US 6,251,571). With respect to instant claims 5-6, Dessauer et al in Example 3, Samples 3-1

Art Unit: 1795

and 3-6 in Tables 5, 6 and 7, anticipate the instant compounds wherein LECV is as set forth in col. 5-6 of Dessauer et al as Leuco Ethyl Crystal Violet. Mere recitation of newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can required applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics. In re Best, Bolton and Shaw (CCPA) 195 USPQ 430. Dessauer et al teaches the extreme reactivity of LECV but shows how to stabilize it to ambient light in acid generating systems.

12. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kerwin (US 3,647,457). The EXAMPLE of Kerwin anticipates the instant invention of claims 5-6 wherein (p-diethylaminophenyl) methane is the leuco dye in the element which colors upon exposure to light.

13. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Nagashima et al (US 4,258,123). With respect to claim 5, Nagashima et al anticipates the instant invention wherein p,p',p''-hexapropyltriaminotriphenylmethane is a species of the genus of pigments claimed. See particularly in Nagashima et al claim 11, last line and lines 35-36 in column 6. Mere recitation of newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can required applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where

Art Unit: 1795

it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

14. Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Frommeld et al (US 4,940,647). With respect to instant claims 5-6, Frommeld anticipates the instant pigments with tris-(p-diethylaminophenyl)methane and tris-(p-dipropylaminophenyl)methane set forth in lines 1-2 of column 3. With respect to instant claims 1-10, Frommeld et al discloses in column 2, lines 1-33, a genus of composition and method of using such that has all but the specific leuco dye of the instant invention.

However, the examples of the preferred leuco dyes set forth by Frommeld et al in the paragraph bridging columns 2-3 is so small as to make each leuco dye listed immediately envisionable in the composition and method of column 2, lines 1-33 of Frommeld et al. There are fourteen listed with only four listed as particularly preferred of these four two are tris-(p-diethylaminophenyl)methane and tris-(p-dipropylaminophenyl)methane. Thus, either because the compositions and methods of Frommeld are immediately envisionable using these two leuco dyes thus anticipating the instant invention or their exchange for the leuco crystal violet in the Examples of Frommeld et al is prima facie obvious to avoid discoloration in dark storage while still remaining to form a good contrast image when exposed to light. The examiner has noted the showings made in the instant specification but these are not with the closest prior art which is that of Frommeld et al.

Art Unit: 1795

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sidney et al (US 5,206,118) teaches forming a dosimeter using an epoxy resin and a leuco dye. In Sidney et al, see particularly Example 13 and Leuco Crystal violet in col. 7. Sharp et al (US 4,229,519) also makes use of a species of the instant compounds for print out images but calls it Leuco propyl violet in Example 21. MacLachlan and MacLachlan et al are cited to show the known properties of leuco ethyl crystal violet (LECV).

16. *Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00 pm.*

17.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cynthia Hamilton/
Primary Examiner, Art Unit 1795

March 11, 2009